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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Daniel G. Schweikert, John F. MacDonald  
Assignee: Sun Microsystems, Inc.  
Title: METAL REGION FOR REDUCTION OF CAPACITIVE COUPLING  
BETWEEN SIGNAL LINES  
Serial No.: 09/452,367 Filed: November 30, 1999  
Examiner: J. M. Mitchell Group Art Unit: 2827  
Docket No.: P-3790

Monterey, CA  
September 26, 2002

Assistant Commissioner for Patents  
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Office Action dated August 27, 2002.

The Examiner is requiring restriction to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1-12 and 14-20, drawn to a device; and
- II. Claims 21-29 and 31-34, drawn to a process.

Applicants hereby elect, with traverse, to prosecute Group I, Claims 1-12 and 14-20. The election is made with traverse since the Examiner has already issued a substantive Office Action on all the claims and thus has failed to show that examination of all the claims would present a serious burden on the Examiner.

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Specifically, MPEP § 803, entitled "Restriction-When Proper", sets forth:

There are two criteria for proper requirement for restriction between patentably distinct inventions:

(A) ...; and

(B) **There must be a serious burden on the examiner if restriction is required ...** (pg. 800-4, August 2001, emphasis added.)

The Examiner asserts:

Because these inventions are distinct for the reasons given above **and have acquired a separate status in the art as shown by their different classification**, restriction for examination purposes as indicated is proper. (Office Action, page 2, emphasis added.)

The Examiner's statement is respectfully traversed. MPEP § 803 further sets forth:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown **if the examiner shows by appropriate explanation of separate classification, or separate status in the art**, or a different field of search as defined in MPEP § 808.02.

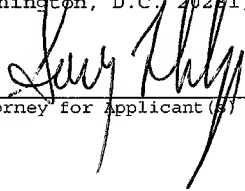
That *prima facie* showing **may be rebutted by appropriate showings or evidence by the application.** (pg. 800-4, August 2001, emphasis added.)

Applicants note that the Examiner issued a substantive Office Action dated April 26, 2002 on all pending claims. This demonstrates a lack of a serious burden on the Examiner to examine all pending claims. Further, in the April 26, 2002 Office Action, the Examiner indicated that Claims 6, 16, and 23 (i.e., Claims from **both** Groups I and II) contain allowable subject matter. Applicants submit that the Examiner is requiring cancellation of claims that have already been examined and found to contain allowable subject matter. Accordingly, restriction is not proper and Applicants hereby request reconsideration and withdrawal of the restriction requirement.

If the Examiner has any questions relating to the above,  
the Examiner is respectfully requested to telephone the  
undersigned Attorney for Applicant(s).

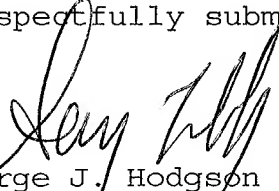
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\_\_\_\_\_  
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Sept. 26, 2002  
Date of Signature

Respectfully submitted,

  
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